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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,932	01/02/2001	Brent Beamer	011338-105	8310

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary

Application No.

09/720,932

Applicant(s)

BEAMER, BRENT

Examiner

Kevin R Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

Claim 14 is objected to because of the following informalities: line 9 of the claim comprises an incomplete sentence ending with “the.” Appropriate correction is required.

Claim 16 is objected to because of the following informalities: the phrase “to adhesive” in line 2 is idiomatic English. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite “a first metallized surface” and “a second nonmetallized surface.” It is unclear whether the claims are trying to differentiate between a first surface that is metallized and a second surface that is nonmetallized, or whether the claimed polymeric moisture barrier comprises more than one metallized surface and more than one nonmetallized surface.

Furthermore, the phrase “low charge retaining coating” is indefinite because the original disclosure does not provide one of ordinary skill in the art any guidance in how to determine when a composition is considered “low charge retaining.” For the purposes of examination, any coating will be considered to meet the “low charge retaining coating” limitation.

Claims 14-22 are held to be indefinite because the phrase "dimensionally stable" is not defined in the specification in such a way that one of ordinary skill in the art could clearly determine the metes and bounds of the present claims.

Claim Rejections - 35 USC § 103

1. Claims 1-6, 8-10, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (US 4,756,414) in view of White (US 4,699,830) for reasons of record.
2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (US 4,756,414) in view of White (US 4,699,830), as applied to claims 1-6, 8-10, 27, and 28, and further in view of Ohlbach (US 4,293,070) for reasons of record.
3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (US 4,756,414) in view of White (US 4,699,830), as applied to claims 1-6, 8-10, 27, and 28, and further in view of Akao et al. (US 4,906,517) for reasons of record.
4. Claims 1 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (US 4,699,830) in view of Dahringer et al. (US 5,689,878) for reasons of record.
5. Claims 1, 14-18, 22, 27, and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,180,615) in view of White (US 4,699,830) and Dahringer et al. (US 5,689,878) for reasons of record.
6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,180,615) in view of White (US 4,699,830) and Dahringer et al. (US 5,689,878), as

applied to claims 1,14-18, 22, 27, and 29 above, and further in view of Rayford et al. (US 4,738,882) for reasons of record.

7. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,180,615) in view of White (US 4,699,830) and Dahringer et al. (US 5,689,878) and Rayford et al. (US 4,738,882), as applied to claims 1,14-19, 22, 27, and 29 above, and further in view of Mott (US 4,756,414) for reasons of record.

Response to Arguments

Applicant's arguments filed November 20, 2002 have been fully considered but they are not persuasive.

Applicant argues that the term "low charge retaining coating" is definite. In support of said argument, Applicant has attached Exhibit 1 to the response, which is a procedure for testing a bags charge resistance. Applicant's argument is not convincing because there is no disclosure in the specification that indicates the procedure of Exhibit 1 was the procedure utilized to determine whether a layer was a "low charge retaining layer." Furthermore, Exhibit 1 does not define what is considered "low" charge retention. As admitted by applicant, there are several such test methods for determining the charge retention of a bag. The examiner assumes each test is slightly different and will give slightly different results. Thus, the examiner maintains the position that the term "low charge retaining coating" is indefinite because there is no clear description of how the charge retention was measured, and no clear guidance to one of ordinary skill in the art how to determine "low" charge retention.

Applicant further argues the term “low charge retaining” is defined on page 5 of the specification. The specification states, “A low charge retaining coating is placed over the metallized surface of the second metallized polymeric moisture barrier. The coating and the metallized surface together have a conductivity of between 10^{-3} to 10^{-10} Siemens.” However, the stated conductivity is a property of the coating and the metallized surface together, and will be affected by the properties of both the metallized layer and the charge-retaining layer. For example, the conductivity of the metallized layer is proportional to the layer thickness. Thus, the taught conductivity does not clarify the metes and bounds of the phrase “low charge retaining layer.”

With respect to the rejection of the term “dimensionally stable” under 35 U.S.C. 112, second paragraph, Applicant argues that it is well known in the art that “dimensionally stable” polymers “do not expand or contract significantly” under heat. However, applicant provides no support for such a definition. Furthermore, the term “significantly” is relative, as is the term “stable.” Neither term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, the rejection is maintained.

Applicant argues that the combination of Mott in view of White would not result in the claimed invention. Specifically, Applicant argues that the metallized layers of White are selected in order to be light transmissive. Transparent metal films, according to applicant, will not provide the claimed moisture barrier properties. However, applicant provides no support for the conclusion that a transparent metal layer will not provide the

claimed moisture barrier properties. The arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. Furthermore, White teaches that the metallized layer and the protective layer (which is taken to read on the claimed low charge retaining layer) should have a conductivity of 10^{-4} - 10^{-8} Siemens (NOTE: the inverse of ohms/square is Siemens). It is known in the art that the thickness of a metallized layer is proportional to the conductivity of that layer. Since the conductivity of the protective layer and the metallized layer taught in White is encompassed by the desired conductivity of the low charge retaining layer and metallized layer taught the present application (see page 5), the examiner concludes that the thickness of the metallized layer taught in White must correlate to the thickness of the claimed metallized layer possessing the claimed moisture barrier properties.

Applicant further argues that the metallized layer of White is not the outer layer. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a metallized outer layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues the examiner's combination of Mott and White with a variety of secondary references. With respect to Ohlbach, applicant argues that the reference teaches a conductive layer made of carbon, not a carbon loaded layer. However, claim 7 clearly claims a "carbon-coated" polymer. Applicant also traverses

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the combination of Mott and White with Akao. According to Applicant, the thickness of the metal layer, not the acrylate protective layer, of the laminate taught in White is utilized to control the film's resistivity. Applicant argues that one of ordinary skill in the art would not look to the teachings of Akao to modify White because Akao teaches modifying the protective layer in order to control conductivity. The examiner respectfully disagrees. White teaches the combination of the metal layer and the protective layer are utilized to control the conductivity of the laminate. Thus, the examiner maintains that one of ordinary skill in the art would have been motivated by the teachings of Akao to add carbon black to the protective coating taught in White in order to obtain the desired aesthetic resistivity.

Applicant also argues the combination of White in view of Dahringer is improper. Applicant argues one of ordinary skill in the art would have destroyed the teachings of White by utilizing a foil layer because White teaches that the laminate is preferably transparent. The examiner initially points out that White teaches that transparent metals are preferred, not required (col 5, lines 59+). Furthermore, the use of a foil barrier gives the additional benefited of being an improved diffusion barrier. Thus, the examiner maintains the position that one of ordinary skill in the art would have been motivated to combine the teachings of White and Dahringer.

The combination of Havens in view of White and Dahringer is also traversed. Applicant argues that both Havens and White teach transparent metal layers and, therefore, do not provide the claimed moisture barrier properties. However, as pointed out above, the examiner has concluded that the metallized layer of the claimed

invention and the thickness of the metallized film taught in White correlate to one another. The metallic layer of Havens is taught to be less than 300 angstroms thick, which overlaps the preferred thickness of the claimed first metallized surface (see page 9, first paragraph). Since each of the metallized layer meet the preferred embodiments of the claimed metallized films, the examiner maintains the combination necessarily meets the claimed moisture barrier properties.

The Brent Beamer declaration has been fully considered, but is not persuasive in overcoming the outstanding rejections. Beamer states that delamination between metal to metal bonds is more prevalent than delamination between metal-polymer bonds. Furthermore, metal-metal delamination results in cracking of the metal layers and, therefore, a loss in the moisture barrier properties of the film. The declaration is not persuasive in overcoming the outstanding rejections because the declaration is not comparing the closest prior art to the claimed laminate. The applied art does not possess metal to metal bonds. Furthermore, the moisture barrier properties of a delaminated film is not the closest prior art. Thus, applicant's arguments are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

KRK

KRK
January 17, 2003

Paul Thibodeau
Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700